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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/284,327	04/10/1999	Benjamin S. Bower	GC516-2-US	2162

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GENENCOR INTERNATIONAL, INC.
ATTENTION: LEGAL DEPARTMENT
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EXAMINER
PATTERSON, CHARLES L JR

ART UNIT	PAPER NUMBER
1652	15

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/284,327	BOWER ET AL.	
	Examiner	Art Unit	
	Charles L. Patterson, Jr.	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 June 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) *14-23* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13 and 24-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 April 1999* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Applicant's election with traverse of Group I, claims 1-13 and 24-29 in Paper No. 14 is acknowledged. The traversal is on the ground(s) that this should be an election of species and that a search and examination of Groups I-V would not be a burden upon the examiner. This is not found persuasive because the proteins of Groups I-V are structurally distinct and therefore were correctly restricted as different inventions, not species. Group I alone requires the search of 4 different sequences and therefore it is maintained that it would be a serious burden upon the examiner to search Groups I-V. The enzymes of Groups I-V are structurally different enzymes and as such are patentably distinct.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-13 and 24-29 not directed to Asn-Asn-(Leu/Phe/Lys/Ile)-Trp-Gly and claims 14-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Previous claims 14-23 have been cancelled. Applicant timely traversed the restriction (election) requirement in Paper No. 14.

Applicants note in their argument that there are 30 claims, not 29. The application filed with the USPTO has 29 claims. In order to try and clarify this discrepancy the examiner asked applicants to fax him a copy of the pending claims that included claim 30. The fax received on 8/5/03 had claims 25 and 27-30 with claim number 26 left out. The copy of the claims filed with the application had claims 27-30 labeled as 26-29. It is noted, as outlined *infra* in the 35 USC § 112 second paragraph rejection, that claim 28 of the present application and claim 29 of the claims in the fax includes two sentences. Perhaps the second sentence was intended to be another claim.

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 because at least the description of Fig. 1 on page 5 and Fig. 6 on page 6 do not contain SEQ ID NOs. Because the application could be examined without this sequence disclosure this has been done, however these disclosures must be included in the specification.

The disclosure is objected to because of the following informalities:

Figure 5 is missing from the application. Two different versions of Figure 4 were sent, with one being labeled "4/5" and the other "5/12". However since this is a 371 application of PCT/US98/25552, and since Figure 5 is present in the PCT application, applicant may add it to this specification.

Appropriate correction is required.

Claims 2 and 24-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is indefinite and confusing in the recitation of "derived from" in line 1. It is not clear whether the phrase is meant to require that the enzyme is from the indicated organisms or perhaps that the enzyme from the source has somehow been "derived from" the enzyme of the indicated organisms by somehow changing it.

Claim 24 is indefinite in that it depends from a canceled claim.

Claim 25-28 are confusing and incorrect in that they are drawn to use claims, which are not allowed in U.S. Patent practice. The claims should be changed to method claims with definite steps.

Claim 28 is confusing and incorrect in that the claim contains 2 sentences. Perhaps the second sentence was intended to be another claim. The claim is also confusing in the recitation of "stonewashing or indigo dyed denim" on line 3. Perhaps "stonewashing of indigo dyed denim" was intended.

It is pointed out that claim 4 does not further limit claim 2 to a fungus but merely further defines the fungus. Therefore this claim and claims 5-11 that depend upon it are not limited to the organisms in these claims.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-13 and 24-29 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention and in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This is a combination written description and enablement rejection.

The specifications teaches that certain primers shown on pages 31-32 were used and that the results are shown in Figure 3. In Figure 3, peptides from *Fusarium equiseti*, *Gliocladium roseum*, *Aspergillus aculeatus*, *Humicola insolens*, *Gliocladium roseum*, *Gliocladium roseum*, *Humicola grisea* and *Emeri-*

cella desertoru have the sequence N-N-(L/F/K/I)-W-G, the sequence elected for prosecution, absent a convincing showing to the contrary. The specification does not enable one of ordinary skill in the art to make and/or use embodiments of the instant claims other that those listed *supra*. Furthermore, the specification would not lead one of ordinary skill in the art to conclude that applicants had embodiments of the scope of the instant claims in their possession at the time the application was filed.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-8, 12-13 and 24 are rejected under 35 U.S.C. 102(b or e) as being anticipated by Ward, et al. (AG) or Fowler, et al. (A). Ward, et al.

teach the instant sequence as residues 19-23 or SEQ ID NO:10 and 21-25 of SEQ ID NO:13. Fowler, et al. teach the instant sequence at residues 19-23 of SEQ ID NO:34. Apparently the two instant reference teach EGIII, but it is impossible to tell if the enzyme of the references have an identity of 30% or 60% to EGIII, as in claim 12-13, since the sequence of EGIII is not given in the specification (see objection to the specification under 37 CFR § 1.821 - 1.825 *supra*).

Claims 1-9, 11-13 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Kitamoto, et al. (BB) or Ooi, et al. (BE). Kitamoto, et al teach the instant sequence at residues 25-39 of Fig. 1B. Ooi, et al. teach the instant sequence at residues 37-41 of Fig. 3. It is impossible to tell if the enzyme of the references have an identity of 30% or 60% to EGIII, as in claim 12-13, since the sequence of EGIII is not given in the specification (see objection to the specification under 37 CFR § 1.821 - 1.825 *supra*).

Claims 1-8, 12-13 and 24-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward, et al. (AG) or Fowler, et al. (A). The references are characterized *supra*. The embodiments of claims 25-29 are taught in Ward, et al. in column 1, line 56 through column 2, line 35 and in Fowler, et al. in column 2, lines 13-29. In addition, applicants admit in the specification that these uses are well known and used in the prior art.

Claims 1-9, 11-13 and 24-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamoto, et al. (BB) or Ooi, et al. (BE) in view of Ward, et al. (AG) or Fowler, et al. (A) and the admitted prior art. The primary references are characterized *supra*. The embodiments of claims 25-29 are

taught in Ward, et al. in column 1, line 56 through column 2, line 35 and in Fowler, et al. in column 2, lines 13-29. In addition, applicants admit in the specification that these uses are well known and used in the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Patterson, Jr., PhD, whose telephone number is 703-308-1834. The examiner can normally be reached on Monday - Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone number is 703-308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Charles L. Patterson, Jr.
Primary Examiner
Art Unit 1652

Patterson
August 25, 2003